

### **REMARKS**

This Amendment and Response is in reply to the Office Action dated September 5, 2003. Therefore, the time period for reply extends up to and includes November 5, 2003. Reconsideration of this application is requested in view of the above amendments and the following remarks. Applicants have amended claims 1 and 18. Nonelected claims 11-17 are canceled. No new matter has been added. Claims 1-10 and 18-21 remain pending in the present application.

### **Interview Summary**

Examiner Chen and Applicant's representative Joshua Randall (Reg. No. 50,719) conducted a phone interview on October 6, 2003, to discuss the cited references and proposed amendments to the claims. The Examiner indicated that the proposed amendments, which amendments are represented in the above Amendments to the Claims, would probably overcome the Johansen reference (U.S. 5,903,415) subject to further search and consideration.

### **§ 102 Rejections**

Claims 1, 2, 7-10, 18 and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Johansen (U.S. 5,963,415). Applicants respectfully traverse this rejection based on the following.

Johansen discloses an electrical discharge protection device 30 that includes a housing 31 and a flex circuit 16 that is secured to the housing 31. A set of separate fingers 53 of a comb 50 extend through slots 48 in the housing and contact test pads 20 formed on the flex circuit. A shunting bar 60 is secured to a top surface of the housing in alignment with the slots 48 such that a ground contact portion 56 of each of the fingers 53 contact the shunting bar 60 when comb 50 is positioned within housing 31.

When the device 30 is assembled, each of the fingers 53 engage one of the test pads 20 and also the bar 60 so as to shunt contacts 20 to each other. In order to perform testing using the discharge protection device 30, all of the fingers 53 remain in electrical contact with flex circuit 16 via test pads 20 while a disrupter is inserted through slots 48 to move one or more of the fingers 53 away from the shunting bar 60. Therefore, when the device 30 is in operation and testing is taking place, the fingers 53 are always in electrical contact with the flex circuit 16. As

a result, Johansen fails to disclose a shunt that has “a first position within the housing in which the electrical contacts are in electrical communication with the circuit and a second position within the housing in which the electrical contacts are not in electrical communication with the circuit,” as required by claim 1. Further, Johansen fails to disclose “means for reversibly shorting a portion of the circuit to be protected by lifting the means for electrically communicating relative to the circuit during operation of a device so as to electrically separate the means for electrically communicating and the circuit, and returning the means for electrically communicating from the lifted position relative to the circuit to a position in which the means for electrically communicating in the circuit are electrically connected,” as required by claim 18. Thus, Applicants submit that Johansen fails to disclose every limitation of claims 1 and 18, and the claims that depend from them. Withdrawal of the rejection is respectfully requested.

### **§ 103 Rejections**

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Johansen in view of Cheung et al. (U.S. 6,335,263). Applicants respectfully traverse this rejection based on the following. As noted above, Johansen fails to disclose every limitation of claim 1. Cheung fails to remedy the deficiencies of Johansen as it relates to claim 1. In particular, Cheung fails to disclose or suggest a shunt having “a second position within the housing in which the electrical contacts are not in electrical communication with the circuit,” as required by claim 1. Therefore, claim 3 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not otherwise concede the correctness of this rejection.

Claim 4 was rejected as being unpatentable over Johansen in view of Combe (U.S. 6,301,087). Applicants respectfully traverse this rejection based on the following. As discussed above, Johansen fails to disclose every limitation of claim 1. Combe fails to remedy the deficiencies of Johansen as it relates to claim 1. In particular, Combe fails to disclose or suggest a shunt that includes “a second position within the housing in which the electrical contacts are not in electrical communication with the circuit,” as required by claim 1. Therefore, claim 4 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not otherwise concede the correctness of this rejection.

**Allowable Subject Matter**

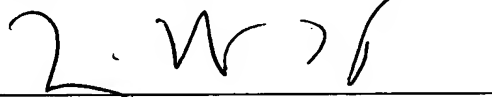
Applicants thank the Examiner for the indication of allowability of claim 21 and the indication of allowable subject matter in claims 5, 6 and 20. In response to the Examiners noted reasons for allowable subject matter, Applicants submit that claims 5, 6, 20 and 21 may be allowable for additional reasons not stated by the Examiner.

In view of the above amendments and comments, favorable reconsideration in the form of a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the foregoing, he is respectfully requested to contact Applicants attorney below at 612.336.4755.

Respectfully submitted,

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